

AMENDMENTS TO THE DRAWINGS

This amendment changes one of the reference numerals “222” in Figure 5 to “220” and changes reference numerals “374” in Figure 5 to “375.” These amendments are made to correct typographical errors and to correspond with an amendment made to paragraph [042] of the specification. No new matter is believed to be introduced by these amendments.

A replacement drawing sheet containing these amendments to Figure 5 is attached.

REMARKS

The present Amendment is in response to the Examiner's Office Action mailed January 17, 2007. No claims are amended. Claims 1-19 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

I. 35 U.S.C. § 112, First Paragraph

The Examiner rejected claim 15 under 35 U.S.C. § 112, first paragraph, on the grounds that it contains "subject matter which was not described in the specification in such a way as to how 'arm is adapted to apply pressure between said cap and said header' perform the function of the invention." *See* Office Action, p. 2. Applicants respectfully traverse the rejection in view of the following remarks.

As a preliminary matter, it is unclear whether the Examiner intended to assert that claim 15 lacks adequate written description support, lacks enabling support, or lacks both. *See* MPEP § 2161 ("The written description requirement is separate and distinct from the enablement requirement."). Therefore, Applicants respectfully request clarification as to which requirement(s) of § 112, first paragraph, provides the basis for the claim rejection.

As to a purported lack of adequate written description support, Applicants respectfully submit that the Examiner has not overcome the "strong presumption that an adequate written description of the claimed invention is present when the application is filed." *See* MPEP § 2163.I.A. "Consequently, rejection of an original claim for lack of written description should be

rare.” See MPEP 2163.03. To establish a *prima facie* case, the Examiner must “set forth express findings of fact which support the lack of written description conclusion,” including “reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.” See MPEP 2163.04.I. Applicants respectfully submit that the Examiner has failed to provide express findings of fact as to “why a person skilled in the art ... would not have recognized that the inventor was in possession of the invention as claimed....” Accordingly, the Examiner has failed to establish a *prima facie* case of lack of written description support.

As to a purported lack of enabling support, Applicants respectfully submit that the Examiner has failed to establish that the specification would not enable one of skill in the art to practice the claimed invention without undue experimentation.

Specifically, Applicant notes that the Examiner has failed to properly state the test for enablement. Particularly, the test for enablement is not simply whether the claimed invention “was described sufficiently in the specification to enable one skilled in the art to make and use the invention.” Rather, it is well established that “The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In Re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).” MPEP § 2164.01 (emphasis added). In light of the foregoing, Applicants respectfully submit that the enablement test articulated by the Examiner is plainly inconsistent with longstanding U.S. Supreme Court and Federal Circuit precedent.

Applicants note, moreover, that a determination that “undue experimentation” would have been needed to make and use the claimed invention is not easily reached. Particularly, the examination guidelines provide that “there are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any experimentation is ‘undue.’ These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;

(C) The state of the prior art;
(D) The level of one of ordinary skill;
(E) The level of predictability in the art;
(F) The amount of direction provided by the inventor;
(G) The existence of working examples; and
(H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.”

MPEP § 2164.01(a) (emphasis added). In connection with the foregoing, the examination guidelines further provide that “It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner’s analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. *Id.* (emphasis added).

As to the aforementioned factors, the examination guidelines explain that “[t]he determination that ‘undue experimentation’ would have been needed to make and use the claimed invention is not a single, simple factual determination. Rather, it is a conclusion reached by weighing all the above noted factual considerations.” *Id.* (emphasis added).

As the foregoing makes clear, the Examiner has not only failed to properly state the test for enablement, but the Examiner has likewise failed to address the issue of undue experimentation as such is contemplated by the enablement test. In fact, the Examiner has provided no evidence or analysis whatsoever concerning the purported lack of written description and/or enabling support regarding claim 15, and has instead simply provided a conclusory statement that the claim fails to comply with the section 112, first paragraph which does not carry the Patent Office burden to set forth a *prima facie* case.

For at least the reasons set forth above, Applicant respectfully submits that the rejection of claim 15 under 35 U.S.C. § 112, first paragraph, should be withdrawn.

II. Obviousness Type Double Patenting Rejection

In the Office Action, the Examiner provisionally rejected claims 1-19 under the judicially created doctrine of obviousness-type double patenting in view of Application Serial No. 10/693,773. Applicants submit herewith a terminal disclaimer relative to Application Serial No. 10/693,773 in order to overcome this rejection. Withdrawal of this rejection and allowance of the pending claims is respectfully requested in view of the terminal disclaimer.

III. PRIOR ART REJECTIONS

A. Rejection Under 35 U.S.C. §102(b)

The Examiner rejects claims 1-3, 5-7, 9, 11-14, 16, and 17 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,666,450 to Fujimura et al. (“*Fujimura*”). Because *Fujimura* does not teach or suggest each and every element of the rejected claims, Applicants respectfully traverse this rejection in view of the following remarks.

Claim 1 recites a device comprising, among other things, “a cap mounted to [a] header,...said cap being mounted to said header by at least one weld point as [a] lens is positioned relative to [a] photonic device so that [a] first optical axis and [a] second optical axis are approximately aligned.”

In contrast, the Examiner has not shown that *Fujimura* teaches or suggests the aforementioned limitation. Referring to Figure 2 and its related disclosure, *Fujimura* is directed to alignment of an optical device group—including laser chip (1), photodiode (2), and lens (6)—with an optical fiber (9). *See* col. 2, ll. 29-35. Thus, *Fujimura* is not concerned with the manner in which the optical device group components (laser chip (1), photodiode (2) and lens (6)) are assembled. In fact, *Fujimura* states, without further elaboration, that “each axis of the semiconductor laser chip (1), the photodiode (2) and the spherical lens (6) has already been aligned at the time of producing the device.” *See* col. 2, ll. 27-30 (emphasis added). Thus, *Fujimura* does not describe a “cap being mounted to [a] header by at least one weld point as [a] lens is positioned relative to [a] photonic device so that [a] first optical axis and [a] second optical axis are approximately aligned,” as claimed.

Claims 7 and 14, although of different scope, include limitations similar to that of claim 1 discussed above. For example, claim 7 recites, among other things, “a step for moving said cap relative to said header to position a first optical axis of said lens proximate a second optical axis

of said photonic device.” In addition, claim 14 recites, among other things, “a capture assembly adapted to hold said header having said photonic device, said capture assembly being movable relative to said cap.” For these limitations, the Examiner relied on the cap (5) and header (3) depicted in Figure 2 of *Fujimura*. However, because the cap (5) is attached to the header (3), as shown in the figure, one is not moveable relative to the other.

For at least these reasons the Examiner has not set forth a proper *prima facie* case of obviousness. Therefore, Applicants respectfully request that the rejection of claims 1, 7, and 14, and corresponding dependent claims 2, 3, 5, 6, 9, 11-13, 16, and 17, be withdrawn.

B. Rejection Under 35 U.S.C. § 103

The Examiner rejected claims 4 and 8 under 35 U.S.C. § 103 as being unpatentable over *Fujimura*; rejected claims 10 and 19 as being unpatentable over *Fujimura* in view of U.S. Patent No. 5,621,831 to Staver et al. (“*Staver*”); and rejected claim 18 as being unpatentable over *Fujimura* in view of Examiner’s Official Notice. Applicants respectfully traverse each rejection.

Insofar as the rejections of claims 4, 8, 10, 18, and 19 rely on the characterization of *Fujimura* advanced by the Examiner in connection with the rejection of claims 1, 7, and 14, such rejections lack an adequate foundation, for at least the reasons outlined at section III.A above. Moreover, the Examiner has not established that either *Staver* or Examiner’s Official Notice are adequate to overcome the deficiencies of *Fujimura* discussed above. Therefore, the rejection of claims 4, 8, 10, 18, and 19, which depend from one of independent claims 1, 7, and 14, should be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 15th day of May, 2007.

Respectfully submitted,

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Attachments: One Replacement Sheet (Figures 4 and 5)
One Annotated Sheet (Figures 4 and 5)
Terminal Disclaimer

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